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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,867	03/03/2004	Hugues Cheron	111393.01	3122
25944	7590	09/14/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	
DATE MAILED: 09/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/790,867

Applicant(s)

CHERON ET AL. 

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date <u>concurrently</u> .                                 |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment filed on August 22, 2005 has been entered. Claim 1 has been amended. Claims 2-10 have been cancelled. No claim has been added. Claim 1 is still pending in this application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite as it defines the PLASTIC outside skin of the bumper as forming the light enabling GLASS, glass and plastic being two different materials. A plastic outside skin can not form the claimed glass.

3. The applicant is advised that in comparing the claim with the Prior Art, The Examiner assumed the outside skin of the bumper as being at least partially formed by a wall of plastic material, with the glass forming part of the outside skin (e.g. attached to the plastic outside skin).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over HANEDA ET AL. (U.S. Pat. 4,996,634) in view of SUZUKI (U.S. Pat. 4,809,144).

5. HANEDA ET AL. discloses a car bumper having:

- **an outside skin at least partially formed by a wall of plastic material (as interpreted from Claim 1), Figure 3, reference number 1;**
- **a light unit (as recited in Claim 1), Figure 3, reference number 10;**
- **the light unit having a housing (as recited in claims 1 and 10), Figure 3, reference number 10; and**
- **the outside skin of the bumper forming at least part of the lighting unit (as recited in Claim 1), Figure 3.**

6. HANEDA ET AL. discloses all the limitations of the claims, except:

- the light unit having a glass for enabling light emitted by the light source to be diffused (as recited in Claim 1); and

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- the glass being the part of the lamp forming part of the outside skin  
(as recited in claim 9).

7. SUZUKI discloses a car headlamp having:

- **a housing (as recited in Claim 1), Figure 1, reference number 1;**
- **a lens (as recited in claims 1 and 10), Figure 1, reference number 2; and**
- **the glass being permanently attached to the housing (as recited in Claim 9), as evidenced by Figure 1.**

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the headlamp of SUZUKI as the light unit of the bumper of teachings of HANEDA ET AL. to prevent the interior of the light unit to accumulate moisture, as per the teachings of SUZUKI.

9. Regarding the lens being part of the outer skin (as recited in claim 9), the Examiner takes Official Notice that the using such glass as part of the outer skin is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the glass of JONES et al. as part of the outside skin of the bumper/lamp combination of HANEDA et al. and SUZUKI. One would have been motivated maintain the aesthetic design profile of the outer skin and to provide a smoother surface with lower drag.

***Response to Arguments***

10. Applicant's request for reconsideration of the finality of the rejection of the last Office Action (Paper No. 20050315) is persuasive and, therefore, the finality of that action is withdrawn.

11. Applicant's arguments filed February 10, 2005 have been fully considered but they are not persuasive.

12. Regarding the Examiner's rejection of claims 1 and 9 (subject matter now presented as Claim 1) under 35 U.S.C. 103(a) as being unpatentable over HANEDA ET AL. (U.S. Pat. 4,996,634) in view of SUZUKI (U.S. Pat. 4,809,144), the applicant argues that the cited combination of references fail to disclose individually, or suggest in combination, all the features of the claimed invention, specifically a car bumper and light unit having a glass for enabling light to be diffused. The applicant further argues that the proposed combination would not have been obvious to one of ordinary skill in the art since SUZUKI fails to provide HANEDA et al. with a glass capable of resisting the deformations anticipated by HANEDA et al. in the event of a collision.

13. In response to applicant's argument that HANEDA ET AL. and SUZUKI fail to disclose individually, or suggest in combination, all the features of the claimed invention, the applicant is advised that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references

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would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, as detailed in Section 5 of the instant Office Action, HANEDA et al. discloses in Figure 3 a car bumper having an outside skin 1 formed by a plastic material, and lamp housing 10 formed integrally with such skin. The lamp housing 10 is open at one end exposing a lamp bulb and socket 17 to the outside. SUZUKI discloses a car lamp having a lamp housing 1 including a lamp bulb 3 and socket, the lamp housing being closed at one end by a lens 2. Using the lens of SUZUKI to close the open end of the lamp housing of HANEDA et al. would have flown naturally to one of ordinary skill in the art to protect the interior of such housing and the lamp bulb and socket from moisture. Survival of the lens of SUZUKI in the event of a collision, while desired, would not be a requirement of the proposed combination. One of ordinary skill in the art would have recognized that, even if such breakable lens of SUZUKI were to be directly incorporated into the integral bumper and lamp housing of HANEDA, such patented structure would still performed as intended (protecting the lamp housing in the event of a collision), while also protecting the interior of the lamp housing from exterior contaminants during normal operation.

In addition, as the applicant is surely aware, the use of lenses for closing lamp housing of motor vehicles (specifically cars) is not only old and well known, but the standard practice in the vehicle illumination art, for protecting the interior of such lamp housings from damage due to moisture and other external agents.

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14. The applicant is further advised that it has been held that the recitation that an element is capable of performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In this case the claimed language reciting "*a housing suitable for containing at least one light source*" and "*a glass enabling light emitted by said light source to be diffused*" fail to positively limit the claim invention. Any housing will meet the claimed limitation, as will any lens including those having no light diffusing properties.

### **Conclusion**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status



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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER  
PRIMARY EXAMINER



September 9, 2005